

REMARKS

Reconsideration of this application is respectfully requested.

Upon entry of the foregoing amendment, claims 1, 5-7, and 9-11 are pending in the application, with claims 1 and 5 being the independent claims. Claims 1, 5, 6 and 9 are sought to be amended. Claims 10 and 11 are sought to be added. Claims 2-4 and 8 are sought to be cancelled by the present amendment without prejudice to or disclaimer of the subject matter therein.

Claim 1 has been amended to clarify Applicant's invention by incorporating the elements of previously-presented claims 2-4 and 8. Support for these changes can be found in the specification as filed, e.g., at page 20, line 29, to page 21, line 14; and in claims 2-4 and 8 as originally filed. Claim 5 has been amended into an independent method claim format, and claims 6 and 9 have been amended accordingly.

Support for the addition of new claims 10 and 11 can be found in the specification as filed, e.g., at page 19, lines 5-18, and page 21, lines 1-14.

These changes are believed to introduce no new matter, and their entry is respectfully requested.

I. The Claims Status Issue

The Examiner contends that the status for claims 1-2 and 6 are not in accordance with 37 C.F.R. § 1.121 and requests appropriate action. (Office Action, paragraph 7, at page 2.)

Applicants have inserted the appropriate status identifiers for each of the claims in the listing above, in accordance with 37 C.F.R. § 1.121, and as discussed in the Manual of Patent Examining Procedure (MPEP), 8th Edition, § 714.II.C, pages 700-240 to 700-242 (September 2007).

II. The Information Disclosure Statement Issue

The Examiner contends that the Abstracts listed on PTO Form 1449 accompanying Applicants' February 18, 2005 Information Disclosure Statement (IDS) were not enclosed. (Office Action, paragraph 9, at page 3.)

Applicants submit herewith a Supplemental Information Disclosure Statement in which the five Abstracts listed in the February 18, 2005 IDS (numbered as Documents A1-A5) are re-submitted as Documents C1-C5.

III. Rejection of the Claims Under 35 U.S.C. § 112, Second Paragraph

The Examiner rejects claims 1-6 under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite. (Office Action, paragraph 12, at page 3.)

Specifically, the Examiner contends that claims 1-2 seem to be difficult to practice because one of skill in the absence of "SE-2000 of Nippon Denshoku (illumination C, field of view 2 degrees)" as listed in Claim 1 and "Senesi-POP" film, will not be able to practice the invention as claimed. (Office Action, paragraph 12, at page 3, lines 13-15.)

The phrases "SE-2000 of Nippon Denshoku (illumination C, field of view 2 degrees)" and "Senesi-POP" refer to components involved in the measurement of the "yellow index" and "gas-barrier property" of the yeast cell wall fraction or film recited in claim 1. Applicants respectfully disagree with the Examiner and note that both phrases are put in context in the specification, in the section discussing measurement of "yellow index," at page 11, line 16, to page 11, line 12 ("SE-2000 . . ."), and in the section discussing measurement of the "gas-barrier property," at page 15, line 25, to page 16, line 20 ("Senesi-POP"). Applicants contend that a person skilled in the art could readily practice both of these methods as recited in claim 1 from the descriptions in the specification.

The Examiner also claims that the limitation "A method for producing . . ." in claim 5 lacks sufficient basis because Claim 1 is not drawn to a method, but to a composition. (Office Action, paragraph 12, at page 3, lines 16-18.)

To expedite prosecution of the application, and without acquiescing to the Examiner's rejection, Applicants have amended claim 5 into an independent claim format, so that claim 5, which is directed to a method, no longer depends from claim 1, which is directed to a composition.

Applicants believe that the rejection of claims 1-6 under 35 U.S.C. § 112, second paragraph, has been overcome and requests that the Examiner withdraw this rejection.

IV. Rejection of the Claims Under 35 U.S.C. § 103

The Examiner rejects claims 1-7 under 35 U.S.C. § 103(a) as allegedly being obvious over the combined teachings of Kasai *et al.*, U.S. Pat. No. 7,238,355 ("Kasai") in view of Sapporo Breweries Ltd., JP 04-248968 ("Sapporo"), and further in view of Greenshields, WO 92/07064 ("Greenshields"). (Office Action, paragraph 14, at pages 4-6.) Applicants respectfully traverse this rejection.

Specifically, the Examiner contends that it would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made to modify teachings from Kasai with those from Sapporo and Greenshields, to obtain the claimed composition and method (Office Action, paragraph 14, at page 4, line 27, to page 5, line 3). The Examiner also contends that it is apparent that one of ordinary skill in the art would have had a reasonable expectation of success in producing the claimed invention (Office Action, paragraph 14, at page 5, lines 6-7.)

Applicants respectfully disagree and submit that Kasai, either singly or in combination with Sapporo and Greenshields, would have failed to provide motivation or an expectation of success for one of skill in the art to arrive at the present invention.

Applicants' claimed composition and method utilize a decolorized yeast cell wall fraction prepared by decolorizing cell residue obtained by removing internal soluble cell components from enzyme-treated yeast, or cell residue obtained by further treating the cell residue with an acid solution and removing the acid solution-soluble components, by using a decolorizing agent and then washing the decolorized cell residue with water or organic solvent. As noted at page 6, line 27, to page 7, line 13, of the specification, Applicants have managed to remove the color and odor from the yeast cell wall fractions of the present invention without impairing their excellent film-forming, gas-barrier and disintegration properties. Thus, the decolorized yeast cell wall fractions of the present invention are excellent in color, and, when formed into a film, possess properties such as oxygen permeability and disintegration times that are excellent when the film is used as a coating agent of pharmaceuticals and the like.

Kasai appears to teach a method for preparing a coating material comprising yeast cell wall fractions consisting of yeast cell residue from which internal soluble cell constituents

have been removed by treating yeast cells by autolysis or external enzymes, and subsequently with an aqueous acidic solution followed by separation. The techniques disclosed in Kasai result in films that possess excellent properties when used as a coating agent, e.g., as described in the present specification, at page 1, line 24, to page 2, line 11. However, problems still remain with such yeast cell wall fractions, such as a yellow-brown to brown color, the possibility of coloring during storage, and the mechanical properties of the film (see page 2, line 12, to page 3, line 8, of the specification).

As the Examiner notes in the Office Action at page 4, Kasai does not teach bleaching or decolorizing the yeast cell wall material. (Office Action, at page 4, lines 9-10.)

Applicants submit that Kasai appears to teach away from the use of additional chemical treatments such as those of Sapporo and Greenshields. See Kasai, at column 2, lines 8-48, in which Kasai states that “the inventors unexpectedly found that residue undergoing no ethanol treatment . . . or any other chemical treatment during the treatment of the yeast extract residue had better film-formability . . . and were particularly better as coating agents which require film properties, and that yeast cell wall fractions without any chemical treatment can be used as an unexpectedly excellent coating agent.”

Applicants submit that one of ordinary skill in the art, at the time the invention was made, would not have been motivated to combine the methods and decolorizing agents in Sapporo and Greenshields with the teachings of Kasai to arrive at the claimed invention, because utilizing the conventional decolorizing and deodorizing methods disclosed in Sapporo might cause the yeast cell wall fractions of Kasai to lose their desirable film properties (specifically, the oxygen permeability and disintegration times of films made from the yeast cell wall fractions, which are important for use of the films as disclosed, e.g., as coating agents for pharmaceuticals, etc.). See the present specification as filed, at page 3, line 9, to page 4, line 20.

Kasai, at the very least, teaches away from the use of methods and decolorizing agents in Sapporo and Greenshields. Applicants thus submit that there would have been no reason for one of skill in the art to combine the teachings of Kasai, Sapporo and Greenshields to arrive at Applicants’ claimed compositions and methods.

Accordingly, Applicants submit that the claimed yeast cell wall fractions and coatings, and methods of making such fractions and coatings, would not have been *prima facie* obvious in light of Kasai, Sapporo and Greenshields. Applicants believe that the rejection of claims 1-7 under 35 U.S.C. § 103 has been overcome and respectfully request that the Examiner withdraw this rejection.

CONCLUSION

Based on the following remarks, Applicants respectfully request that the Examiner reconsider all rejections and that they be withdrawn. Applicants believe that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check or credit card payment form being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicants hereby petition for such extension under 37 C.F.R. § 1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

Date May 12, 2008

By Ann E. Summerfield

FOLEY & LARDNER LLP
Customer Number: 22428
Telephone: (202) 672-5569
Facsimile: (202) 672-5399

Ann E. Summerfield
Attorney for Applicants
Registration No. 47,982